Office - Supreme Court, U.S.
FILED
AUG 2 1957
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1957

No. 271

UNITED MFG. & SERVICE CO.,
(Now by change of name UNILECTRIC, INC.),
Plaintiff-Petitioner,

vs.

HOLWIN CORPORATION,
Defendant-Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI.

JAMES R. MCKNIGHT
105 West Adams Street
Chicago 3, Illinois
Counsel for Respondent

The Scheffer Press, Inc.—ANdover 3-6850

INDEX

	PAGE
Statement of the case	1
Argument	3
The petition presents no proper ground for granting a petition for certiorari	3
I	3
II	3
III	4
The petition sets forth none of the usual grounds for granting a petition for writ of certiorari	4
Conclusion	5

Table Of Cases.

Mellows Company v. Shoe Machinery Company, 316 U.S. 364, 367	3

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1957

No. 271

UNITED MFG. & SERVICE CO.,
(Now by change of name UNILECTRIC, INC.),
Plaintiff-Petitioner,

vs.

HOLWIN CORPORATION,
Defendant-Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI.

STATEMENT OF THE CASE.

In this case, petitioner is a licensee under respondent's patent No. 2,460,636. After the agreement was entered into, petitioner made a slightly different device and filed suit for declaratory judgment claiming non infringement. Respondent counterclaimed for payment under the license agreement. The United States Court of Appeals for the Seventh Circuit held that respondent could proceed under its counterclaim and that petitioner being a licensee was estopped to contest the validity of respondent's patent in

187 Fed. 2d 902, and remanded the case to the District Court. Petitioner then began repeated efforts to attack the validity of respondent's patent under the guise of claim of fraud. The District Court held that petitioner had proved no fraud, but had merely made assertions of fraud. The Court of Appeals in its decision held that petitioner's claim of fraud "must fail for want of proof". (A-11 of petitioner's appendix).

ARGUMENT.

THE PETITION PRESENTS NO PROPER GROUND FOR GRANTING A PETITION FOR CERTIORARI.

The Court of Appeals has ruled that there is no evidence of fraud in the procurement of respondent's patent. This Court accepts the facts as found below and will not review the weight of the evidence, *Mellows Company v. Shoe Machinery Corp.*, 316 U.S. 364, 367.

Responding to the three numbered paragraphs in the petition, respondent states:

I.

There is no taint of fraud in this case. In fact there is no proof of any fraud of any kind. The Court of Appeals held that fraud was merely an argument on the part of petitioner (A-10) and "must fail for want of proof" (A-11). The decisions cited in the petition differ in that fraud had been established therein by evidence. There was no evidence of fraud in this case. Respondent came into Court and is before this Court, with clean hands. Petitioner's argument urging fraud is without basis.

II.

The drawings between pages 14 and 15 and the sketches between pages 16 and 17 of the petition were never in evidence before the District Court, or the Court of Appeals. They are unsupported argument, and are not a part in any way of this case. They cannot furnish any basis for granting a petition for Writ of Certiorari.

III.

There are no facts in this case laying any basis for file wrapper estoppel. The District Court so found. The Court of Appeals agreed and ruled as follows: (A-9)

> "An examination of cancelled Claim 4 shows that it was general in character and from all that appears it was cancelled voluntarily for the reason that it added nothing of value to the other claims. We see nothing in the file history of the Holloway patent that either compelled the cancellation of Claim 4 to avoid prior art or estops defendant from claiming its right to a reasonable range of equivalents under Claim 3. The applicable rule is stated in 69 J.C.S., Patents, Sec. 212, p. 725, as follows: 'The voluntary cancellation of a claim in an application for a patent does not create an estoppel, affecting the construction or scope of other claims as allowed.' The district court adopted as a conclusion of law: 'There is no file wrapper estoppel limiting the scope of Claim #3 of defendant's patent aforesaid'."

There is no conflict with the decisions of this Court.

THE PETITION SETS FORTH NONE OF THE USUAL GROUNDS FOR GRANTING A PETITION FOR WRIT OF CERTIORARI.

There are no special or important reasons why the petition should be granted. This is a simple case of breach of contract between two private litigants. The Court of Appeals held against the petitioner and it is dissatisfied.

(a) The holding is in accord with the decisions of this Court.

(b) There is no conflict between Courts of Appeal.

(c) There is no important question of Federal Law which has not been settled by this Court.

(d) The Court of Appeals did not depart from the accepted and usual course of judicial proceedings in this case; it acted strictly in accordance with the usual and accepted course.

CONCLUSION.

This case presents no conflict of opinion. The case is invested with no public interest. No important question of law is involved. There has been no departure from established principles applicable to such a suit. The petition should be denied.

Respectfully submitted,

JAMES R. MCKNIGHT,
Counsel for Respondent.

Dated: August 1, 1957